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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/930,235	02/23/1998	ANJA EITRICH	BEIERSDORF45	2748
7055 7590 01/17/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 01/17/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	08/930,235	EITRICH ET AL.	
	Examiner	Art Unit	
	Daniel S. Metzmaier	1796	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 12-17, 19, 20, 23, 24, 26, 32, 33, 35-37 and 41-47.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached detailed action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: Encl.: PTO-892.

DETAILED ADVISORY ACTION

Claims 12-17, 19-20, 23-24, 26, 32-33, 35-37 and 41-47 are pending.

The amendment to the specification obviates the issue related to paragraph number 1 of the final action.

Interpretation of the claims

1. The claims set forth cosmetic compositions as transparent or translucent oil-in-water microemulsions employing O/W polyalkoxylated emulsifiers with a total emulsifier content of less than 20 %, preferably less than 10 %, most preferably less than 8 % by weight. Said microemulsions are made by employing the phase inversion temperature method of making said microemulsion. The examples are exemplary rather than comparative.

Response to Arguments

2. Applicant's arguments filed 02 January 2008 have been fully considered but they are not persuasive.

3. Applicants (page 6 of After Final response) assert the rejection that the claims are indefinite is traversed for the reasons set forth in the response filed 17 August 2007, which are substantially reproduced as follows:

Applicants respectfully traverse this rejection. In particular, claims 12 and 36 recite that the oil phase consists essentially of constituents of low volatility and comprises at least one of the substances listed therein. One of ordinary skill in the art will readily understand what this means. The term "comprises" merely indicates that one or more substances which differ from the recited substances may additionally be present in the oil phase as long as in this case the oil phase still consists essentially of constituents of low volatility.

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Applicants' arguments have not been deemed persuasive since the claims are internally inconsistent regarding the scope of the oil phase by virtue of the use of intermediate transitional language followed by open transitional language defining said oil phase. This is clearly set forth in the rejection as a fact of how the claims are drafted. Further elaboration is not deemed as required.

4. Applicants (pages 6 and 7) assert: "... the rejection fails to give any reason why it would allegedly have been obvious to one of ordinary skill in the art to use one or more of the components of the oil phase recited in, for example, present claim 12 in the perfume formulations of McGEE." This has not been deemed persuasive for the following reasons:

(1) McGee et al (column 5, lines 29, cited in the rejection) clearly contemplates mixtures of perfumes.

(2) McGee et al discloses the use of both ethylene glycol monophenyl ether and fatty alcohols in the exemplified compositions. All disclosures in a reference must be considered for what it fairly teaches those of ordinary skill in the art, not just preferred embodiments or specific working examples. *In re Boe*, 355 F2d 961, 148 USPQ 507, (CCPA, 1966). *In re Chapman*, 357 F2d 418, 148 USPQ 711, (CCPA, 1966). *In re Mills*, 470 F2d 649, 176 USPQ 196, (CCPA, 1972).

(3) McGee et al further (column 6, lines 43-59, particularly 59) discloses the perfumes may contain non-ethanolic diluents, which the skilled artisan recognizes dibutyl phthalate as a solvent/diluent for perfumes.

(4) McGee et al (column 7, lines 40-46) discloses cosmetic additives reading on those claimed as commonly added formulating ingredients. These clearly include emmollients, silicones, among other ingredients well known in the cosmetic field.

In conclusion, McGee et al clearly discloses the use of cosmetic additives, hydrocarbon perfumes and the use of alkyl ether sulfates as claimed. The use of said materials is for their art recognized function, e.g., cosmetic function of emollience, skin protectants, ect. (cosmetic additives), perfume or fragrance (hydrocarbon perfumes) and emulsifier (alkyl ether sulfates). To the extent applicants demand an explicit recitation of the combination, said explicit recitation would amount to an anticipation rejection rather than the obviousness rejection as set forth. To the extent applicants demand the reference provide an explicit recitation of motivation for a particular combination. The recent KSR decision forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Please see the Board of Appeals decision *Ex parte Smith*, USPQ2d, slip op at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices.dcom.bpai/prec/fd071925.pdf>).

5. Regarding applicants' (page 7) arguments directed to the use of specific cosmetic ingredients in perfume compositions, attention is directed to the preceding paragraphs regarding the McGee et al reference.

6. Applicants (pages 7 and 8) assert the emulsions of Henkel KGaA, DE 4,318,171, (especially Beispiele, Tabelle 1, PIT-Emulsionen, and abstract) as evidenced by

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Derwent Abstract, AN 1995-014884, are not microemulsions based on the Henkel

KGaA, DE 4,318,171, page 2, lines 28-31, which is characterized as reading:

The droplet diameter of such finely divided emulsions - in the following referred to as PIT emulsions - is of an order of magnitude of 100-300 nanometers (nm), i.e., they are not yet optically isotropic, single-phase systems as are present in solubilizates and microemulsions, the particle diameters of which are far below 100 nm.

While said reference PIT emulsions are disclose as not yet optically isotropic, single phase solubilizate or microemulsion systems having particle diameters far below 100 nm, the reference does not exclude microemulsions *per se*. Applicants' claims are directed to "translucent or transparent oil-in-water microemulsions". Translucent microemulsions are not optically isotropic, single phase solubilizate or microemulsion systems.

The citation set forth by applicants is a clear indication that the reference exemplified and disclosed PIT emulsions are not isotropically, single phase microemulsions having a particle diameter of far below 100 nm. Applicants' claims are not limited to optically isotropic, single phase microemulsions having a particle diameter far below 100 nm. Applicants claims fail to limit the particle diameter at all. Said claims read on any translucent or transparent oil-in-water microemulsions having the components as set forth in the claims.

7. Applicants (page 9) assert that the rejection concedes Henkel KGaA '171 in view of Derwent Abstract, '884 differs from the claims regarding the further addition of allegedly conventional cosmetic ingredients and applicants further assert the secondary references fail to cure said deficiency.

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While Henkel KGaA '171, in view of Derwent Abstract '884, may not explicitly disclose specific cosmetic ingredients, the Henkel/ AN 1995-014884 disclose the use of said compositions in shampoos, bath additives, liquid soaps, shower preparations, and dish washing detergents. Said compositions used in the disclosed utilities would include a voluminous number of cosmetic compositions expected to have common cosmetic additives, conventionally shown in the prior art by the secondary references.

Applicants (page 9) further assert Henkel/ AN 1995-014884 does not disclose cosmetic preparations as a microemulsion. This has not been deemed persuasive for the following reasons: (1) regarding whether Henkel KGaA '171, in view of Derwent Abstract '884 teach compositions in the form of a microemulsion, this has been addressed above. Furthermore, (2) since the claims are directed to compositions, the intended use as a cosmetic preparation is given little weight and the Henkel KGaA '171, in view of Derwent Abstract '884 at least suggested use of the compositions as cosmetics.

Applicants (page 9) assert Rosano lacks a teaching a microemulsion as a cosmetic. This has not been deemed persuasive since Rosano (column 1, lines 41 et seq) discloses that the basic theory of microemulsions is described in "Journal of Society of Cosmetic Chemist", v. 25, pp. 609-619, (November 1974). Rosano further (column 14, lines 20-28, particularly 23-28) sets forth:

The water-immiscible liquid may have a dominant portion of a light mineral oil. A representative oil is n-hexadecane, although obviously mixed oils can be used. The mineral oil can be used either alone or as a solvent for a number of lipophilic substances such as siloxane, lanolin, and hair or skin conditioners, or similar emollients.

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It is reasonable to conclude the compositions of Rosano and the disclosure of hair or skin conditioners or similar emollients would be intended for cosmetic compositions.

Applicants (page 9) assert the Rosano reference (directed to methods of making microemulsions including the selection of surfactant mixtures) is completely unrelated to PIT methods disclosed in the Henkel I reference. References are properly combinable if they are directed to solving the same problem or they reasonably are directed to the same field of endeavor. Clearly the references are directed to same field of endeavor of making emulsions having small droplet size.

Applicants (page 10) further assert that Hoppe et al, Unilever and P & G do not exemplify microemulsions and P & G expressly says the concentrates are not microemulsions. This has not been deemed persuasive since the secondary references are cited to show art known use of alkyl ether sulfates or nonionic ethoxylates in combination or alternatively with alkyl ether carboxylates in cleaning and/or hair care compositions and not the specific use in microemulsions. Said combination is clearly suggested in the prior art, i.e., a *prima facie* case of obviousness has been presented. Applicants have not shown the compositions to be obvious therefrom.

Applicants (page 10) assert P & G is directed to hard surface compositions rather than cosmetics including dishwashing compositions. The dishwashing compositions would include hand or machine and would require the same mildness of the surfactants as cosmetic compositions. One skilled in the art would look to known stable clear surfactants systems as suitable surfactants for cosmetic cleaning compositions.

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Applicants' (page 10) assertions that there is no reasons to employ the exemplified shampoo surfactant of Hoppe et al (Alkypo RLM 150, a fatty alcohol polyglycol ether carboxylic acid) in Henkel '171 has not been deemed persuasive since said surfactant is a suitable surfactant for the shampoo use disclosed in the Henkel '171 reference.

Applicants' (page 10) assertions that Unilever does not disclose microemulsions has not been deemed persuasive Unilever teaches additives that may be used in microemulsion form.

Applicants' (page 10) assertions that Unilever does not disclose w/o anionic emulsifiers has not been deemed persuasive Unilever teaches additives that are the same or substantially the same as those claimed in claims 36, 41 and 44 as alkyl ether carboxylates having 8-18 carbons in the alkyl group and 1-10 ethoxy groups.

The prior art teaches compositions as very fine emulsions reading on the translucent microemulsions claimed and the emulsified/surfactants and additives for use in the utilities disclosed therein. A *prima facie* case having been presented, applicants have not rebutted the *prima facie* use of said additives in the claimed compositions.

8. Applicants (page 11) question the basis of the rejection over Henkel '041. The basis for said rejection is essentially as set forth above for the related Henkel KGaA, DE 4,318,171, and Derwent Abstract, AN 1995-014884. This is set forth in the Office Action.

Applicants (pages 11 and 12) assert that Henkel '041 lacks a disclosure of a microemulsion and discloses diluted emulsions of 227-660 nm rather than far below 100

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nm. This has not been deemed persuasive since the less than 1 micron would include microemulsions and the historical definition of a microemulsion has been the absence of observable droplets under an optical microscope, which are generally observable down to about 250 nm. See above remarks regarding the disclosure of Henkel I or Henkel '171. See Also Milton J. Rosen, SURFACTANS AND INTERFACIAL PHENOMENA (John Wiley & Sons, New York, NY, copyright 1978) page 224, 05-1983 (of record).

The comments regarding HENKEL II in view of Derwent Abstract, AN 1995-171245, Rosano, Hoppe et al, Unilever and/or P & G have been addressed above.

Furthermore, See also MPEP 2144.05(I) wherein it sets forth, "A *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. ***Titanium Metals Corp. of America v. Banner***, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)." In the instant case, the microemulsions may differ from the prior art very fine emulsions but said difference would be a difference in degree rather than kind.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1796

DSM